

## REMARKS

### AMENDMENTS TO THE SPECIFICATION

The Specification has been amended to clarify priority by including the necessary reference to the prior art application. Additionally, the Specification has been amended to clarify that the parent application of which this is a divisional of has issued as U.S. Patent No. 6,665,586.

Additionally, the Specification, page 7, line 2 has been amended to include reference to numeral 89 which identifies the step of the documents being stapled or bound. No new matter is added by the amendment as the new reference number simply calls out that which was already referenced in the Specification.

### AMENDMENT TO THE DRAWINGS

The drawings have been objected to under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. Numeral 89 has been added to Figure 5. Reference numeral 89 refers to the step of stapling or binding the documents together to form a single packet.

### STATUS OF THE CLAIMS

Claims 1, 3 and 4 are pending in the present matter. Claims 1 and 3 have been amended. Applicant now believes that the claims are in proper form for allowance.

## ISSUES UNDER 35 U.S.C. § 112

Claim 3 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claim 3 to correct a second positive recitation of "shipping label". Claim 3 now claims "the shipping label" instead of "a shipping label". Applicant respectfully requests that the Examiner's rejections be withdrawn.

## ISSUES UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,040,132 to Schuricht in view of U.S. Patent No. 5,114,128 to Harris. The Applicant respectfully traverses this rejection.

"To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." MPEP 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *Id.* The combination of Schuricht and Harris does not teach each and every limitation of independent claim 1 especially in light of the amendments to claim 1.

Claim 1 has been amended to include the limitation that the method of printing include "determining a time to print" and that it includes "correlating the time to print, time required to deliver and desired date of receipt to determine a time to begin printing the document." Additionally, claim 1 has been amended to include the limitation of "associating each shipping label physically with each document."

The combination of Schuricht and Harris does not disclose utilizing three variables to determine a date to print. The three variables specified in claim 1 are: time to print, time to

deliver and desired date of receipt. The Examiner asserts that Schuricht teaches determining a time to deliver, a desired date of receipt, and printing each document at a time sufficiently early to enable delivery of each document on the desired date of receipt. The Examiner's interpretation of what Schuricht teaches is erroneous.

The Examiner relies upon column 3, lines 17-21 to teach determining a time necessary to deliver each document to the intended delivery location (Final Office Action, page 3, lines 19-20). Schuricht does not teach this, but instead simply teaches that "the user may define in information block 14 for each shipping mode of each carrier the user desires to engage from time to time. The desired shipping mode can include overnight air express, parcel post, and air and surface rate." The selection of a mode of transportation does not teach determining a time required to deliver the document. Each of the modes described can vary in duration. Even overnight express cannot be guaranteed to arrive the next day as the Post Office only guarantees that the document will arrive within the next two days.

The Examiner is also mistaken in that Schuricht does not disclose determining a desired date of receipt. Instead, Schuricht teaches that "with the address information supplemented by the coded information of customer's preferred shipping mode and/or preferred special service, the system may then automatically access preferred shipping mode and/or preferred special service when access is made to the receiver address by the keyboard means." (Column 9, line 66 through column 10 line 4). This does not disclose determining the receipt date. Schuricht simply allows for a user of the system to see the preferred shipping method desired by the receiver. This is not the date that the documents are to arrive.

Finally, the Examiner relies upon Schuricht to teach printing the documents with sufficient time so that the documents are delivered on the desired receipt date. This is not what is

taught by Schuricht. Schuricht simply teaches that the documents are prepared by the system with the preferred mode and preferred special services without any need of the user to manually enter a shipping mode and/or special service. Schuricht does not teach printing each document at a specific time so that it arrives on a specific date. Just because Schuricht teaches the selection of a specific mode of transportation does not mean that it teaches that the mode is designed to calculate when a print job should be started.

The Examiner appears to rely upon Harris to teach that the method of printing mailing labels can be done in line or off line. Harris does not teach "correlating the time to print, time required to deliver and desired date of receipt to determine a time to begin printing the document." As shown above, Schuricht does not teach this limitation either. As each and every limitation is not taught by the combination of prior art references, Applicant respectfully requests that the Examiner withdraw this rejection. As claims 3 and 4 depend from an allowable base claim, Applicant respectfully requests that they be allowed.

Dependent claim 3 has been rejected as being obvious in view of the combination of Schuricht, Harris and Boss. Applicant respectfully traverses this rejection. The inclusion of Boss does not rectify the deficiencies addressed previously regarding independent claim 1. Applicant respectfully requests that the rejection of claim 3 be withdrawn as the combination of the prior art references do not disclose each and every limitation of claim 3.

## CONCLUSION

Applicant submits that the claims, as amended, are in proper form for allowance. This amendment accompanies the filing of a Request for Continued Examination (RCE). Please charge Deposit Account No. 26-0084 the amount of \$395.00 per the attached Request for

Continued Examination Transmittal. Please also consider this a three-month extension of time from July 3, 2006 to October 3, 2006 and charge Deposit Account No. 26-0084 the amount of \$510.00 for this extension. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Scott Johnson', is written over the typed name and firm information.

R. SCOTT JOHNSON, Reg. No. 45,792  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
**CUSTOMER NO: 22885**  
Attorneys of Record

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